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EXAMINER
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WONG, LESLIE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* GREGORY A. STOBBS  
and  
JOHN V. BIERNACKI

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Appeal 2010-012069  
Application 09/499,238  
Technology Center 2100

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Before SCOTT R. BOALICK, DENISE M. POTHIER, and  
BARBARA A. BENOIT, *Administrative Patent Judges*.

POTHIER, *Administrative Patent Judge*.

DECISION ON APPEAL

## STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-7, 11-22, 31, and 32. Claim 25 has been canceled, and claims 8-10, 23, 24, and 26-30 have been withdrawn from consideration. App. Br. 3.<sup>1</sup> We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

### *Invention*

Appellants' invention relates to a process for performing patent portfolio analysis. *See generally* Abstract. Claim 1 is reproduced below with a key disputed limitation emphasized:

1. A computer-implemented patent portfolio analysis method comprising:
  - retrieving a corpus of patent information from a database, said patent information including multiple claims from a plurality of patent documents;
    - automatically determining claim breadth metrics* for the multiple claims by using computer to measure claim length;
    - associating a claim breadth metric with a claim and storing said associated claim breadth metric in a computer-readable dataset,
    - wherein a claim breadth metric which is associated with a claim is indicative of how broad the claim is.

The Examiner relies on the following as evidence of unpatentability:

Risen	US 6,018,714	Jan. 25, 2000 (filed Nov. 8, 1997)
Snyder	US 6,038,561	Mar. 14, 2000 (filed Sept. 15, 1997)
Petruzzi	US 6,049,811	Apr. 11, 2000 (filed Nov. 26, 1996)
Rivette	US 6,339,767 B1	Jan. 15, 2002 (filed Aug. 29, 1997)

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<sup>1</sup> Throughout this opinion, we refer to (1) the Appeal Brief filed February 15, 2010; (2) the Examiner's Answer mailed April 27, 2010; and (3) the Reply Brief filed June 25, 2010.

*The Rejections*

1. The Examiner rejected claims 1-7, 11-16, 18-22, 31, and 32 under 35 U.S.C. § 103(a) as unpatentable over Snyder, Risen, and Petruzzi. Ans. 4-22.
2. The Examiner rejected claim 17 under 35 U.S.C. § 103(a) as unpatentable over Snyder, Risen, Petruzzi, and Rivette. Ans. 22-23.

THE OBVIOUSNESS REJECTION OVER SNYDER,  
RISEN, AND PETRUZZI

Regarding representative claim 1,<sup>2</sup> Appellants argue that Risen relies on a human assessment of metrics and fails to teach automatically determining the claims breadth metrics for multiple claims. App. Br. 16-19. Appellants also assert that Risen teaches away because “[t]here is nothing in the Risen reference to suggest that the file history would be analyzed automatically, thus it is apparent that Risen contemplates that a human would perform the claim breadth assessment.” App. Br. 20. Appellants further contend that Petruzzi does not cure this alleged deficiency. App. Br. 22-23.

ISSUE

Under § 103, has the Examiner erred in rejecting claim 1 by finding that Snyder, Risen, and Petruzzi collectively would have taught or suggested

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<sup>2</sup> Appellants contend that claims 1, 11, 31, and 32 are each representative. App. Br. 15-16. However, claims 11, 31, and 32 include similar “automatically” steps to claim 1 and are not separately argued from claim 1. See App. Br. 16-24. Additionally, Appellants also state “the claims on appeal may be grouped together into [a] single group . . . .”

automatically determining claim breadth metrics for the multiple claims by using a computer?

### ANALYSIS

Based on the record before us, we find no error in the Examiner's rejection of claim 1, which calls for automatically determining claim breadth metrics for multiple claims by using a computer. At the outset, we stress the Examiner's rejection for claim 1 relies on the teachings of Snyder, Risen, and Petruzzi collectively -- not Risen alone -- to teach the disputed automatically determining step. *See* Ans. 4-7, 24-27. For this reason, we find the arguments concerning what Risen alone teaches unpersuasive (*see* App. Br. 16-19) and not consistent with the rejection as presented by the Examiner.

The Examiner discusses Snyder's teaching of a computer system that has database with patent information and using this information to analyze claims and portfolios. Ans. 4-5 (citing col. 4, ll. 3-18, col. 11, ll. 22-28); *see also* Figs. 1B-2A. While Snyder does not specifically teach automatically determining claim breadth metrics, Snyder suggests using a computer to automate steps for analyzing claim sets, clustering based on similarities, and comparing claims. *See id.*

Nonetheless, the § 103 rejection focuses on Risen and Petruzzi to teach automatically determining claim breadth metrics for multiple claims. Ans. 5-7. Particularly, Risen teaches techniques for valuing patents, including computing a value based on the breadth of the patent claims. Ans. 5 (citing col. 9, ll. 21-29). Such a technique of determining claim breadth metrics in Risen would be helpful to Snyder's system that analyzes

claims and clusters based on similarities. That is, an ordinary skilled artisan employing inferences and creative steps would have recognized that determining the claim breadth would assist in determining claim similarities and analyzing claim as performed by Snyder. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 417-418 (2007). Also, as the Examiner notes (Ans. 6), including such a valuation in Snyder would assist in identifying a claim's scope and determine an insurance premium for an asset. *See* Ans. 6.

The Examiner additionally cites to Petruzzi to illustrate that an ordinarily skilled artisan would have recognized automating processes to provide a faster and more efficient way to complete tasks. *See* Ans. 6-7. We agree. Petruzzi is cited for the limited purpose of teaching that automating processes are known to artisans. *See id.* Contrary to Appellants' position (Reply Br. 12), this conclusion is further supported by legal precedent discussed by the Examiner (Ans. 7, 25-26), which indicates that accommodating prior art human activity or mechanical devices with modern electronics would have been reasonably obvious to one skilled in the art. *See Leapfrog Enterprises, Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007); *see also In re Venner*, 262 F.2d 91, 95 (CCPA 1958). Thus, Risen's discussion of using humans to arrive at valuations does not teach away from automating the step of determining claim breadth metrics. *See* App. Br. 20. Rather, including such an automation feature would have been recognized by an ordinarily skilled artisan as an improvement to the Snyder/Risen system so that such a system can be faster and more efficient. *See KSR*, 550 U.S. at 417.

For the first time in the Reply Brief, Appellants assert several new arguments, including: (1) Snyder is not germane to Appellants' invention

(Reply Br. 5-6); (2) Risen teaches calculating a monetary value for a patent in gross and not associated with a claim (Reply Br. 6-7); (3) an ordinarily skilled artisan would not recognized a connection between Petruzzi's counting of words in an abstract and counting a claim length (Reply Br. 6-7); (4) the obviousness factors under *Graham v. John Deere Co.*, 383 U.S. 1 (1966), have not been properly performed (Reply Br. 7-10); and (5) the Examiner has only provided conclusory statements and has not articulated a reason with some rational basis for combining the references to arrive at the claimed invention (Reply Br. 10-13). Such arguments are waived. *See Ex parte Borden*, 93 USPQ2d 1473, 1474 (BPAI 2010) (informative) (“[T]he reply brief [is not] an opportunity to make arguments that could have been made in the principal brief on appeal to rebut the Examiner's rejections, but were not.”).

Even so, we have addressed many of these contentions in the above discussion. Regarding Risen only calculating a value for a patent in gross, we disagree. In order to determine this composite value, Risen considers and calculates a value for the breadth of the patent claims, and to determine this composite value, Risen suggests determining a metric for each claim in the patent. *See* col. 9, ll. 21-29. Risen thus suggests at a minimum determining a claim breadth metrics for the multiple claims and associating a claim breadth metric with a claim as recited. Moreover, “all that is required of the office to meet its prima facie burden of production is to set forth the statutory basis of the rejection and the reference or references relied upon in a sufficiently articulate and informative manner as to meet the notice requirement of [35 U.S.C.] § 132.” *In re Jung*, 637 F.3d 1356, 1363 (Fed. Cir. 2011).

For the foregoing reasons, Appellants have not persuaded us of error in the rejection of independent claim 1 and claims 2-7, 11-16, 18-22, 31, and 32 not separately argued with particularity.

#### THE REMAINING REJECTION

For the remaining obviousness rejection, Appellants refer to the previous arguments of claim 1 and assert that Rivette does not supply the purported missing element from Snyder, Risen, and Petruzzi. App. Br. 25. The issues before us, then, are the same as those in connection with claim 1, and we refer Appellants to our previous discussion. We need not address whether Rivette cures any alleged deficiency and will sustain the rejection of claim 17.

#### CONCLUSION

The Examiner did not err in rejecting claims 1-7, 11-22, 31, and 32 under § 103.

#### DECISION

The Examiner's decision rejecting claims 1-7, 11-22, 31, and 32 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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